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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,981	03/14/2002	Florence L'Alloret	220760USOPCT	2976
22850	7590	04/05/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EGWIM, KELECHI CHIDI	
			ART UNIT	PAPER NUMBER
			1713	
DATE MAILED: 04/05/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/069,981

**Applicant(s)**

L'ALLORET, FLORENCE

**Examiner**

Dr. Kelechi C. Egwim

**Art Unit**

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 25-69 is/are pending in the application.
- 4a) Of the above claim(s) 27,31,34,35,37,38,46-48,50-53,56-60 and 62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25,26,28-30,32,33,36,39-45,49,54,55,61 and 63-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/02/2006 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claim 49 is still rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear if applicant is claiming a block polymer or graft polymer. This claim seems to be requiring the two different structures the same time.

***Claim Rejections - 35 USC § 102***

4. Claims 25, 26, 28, 30, 32, 33, 40-45, 49, 55 and 65-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Merchant Jr. et al., for reasons stated in previous Office Actions.

5. Claims 25, 26, 28, 29, 33, 40-45, 49, 55 and 65-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Koerner et al., for reasons stated in previous Office Actions.

6. Claims 25, 26, 28, 29, 32, 33, 39-45, 49, 55 and 63-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Fogel et al., for reasons stated in previous Office Actions.

***Claim Rejections - 35 USC § 103***

7. Claims 25, 26, 28-30, 32, 33, 36, 39-45, 49, 54, 55, 61, 63, 64 and 65-69 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Maroy et al., for reasons stated in the previous Office Action.

***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

Art Unit: 1713

F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 25, 26, 28-30, 32, 33, 36, 39-45, 49, 54, 55, 61, 63, 64 and 65-69 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of 44-46, 104, 110, 116, 119, 125, 126, 131, 134-136 and 143-144 copending Application No. 10/069,983, for reason stated in the previous action

### ***Response to Arguments***

9. Applicant's arguments filed 03/02/2006 have been fully considered but they are not persuasive.

10. Even though applicant argues against one of the examples in Merchant, this (maleic anhydride grafted to an alkyl phenol formaldehyde resin) is only in a the small group of LCST containing water-soluble polymers taught in Merchant (See in col. 6), including oxyalkylated amines, glycol resin esters, oxyalkylated polyols and oxyalkylated alky-phenol formaldehyde resins.

Art Unit: 1713

11. Regarding Koerner, the particular polymer of example 8 has a cloud point at a **higher concentration** than the concentration (4%) that recited in the claims (1%). This is not the same concentration for lack of a cloud point required in applicant's claims.

Also, col. 5, lines 27-34, lists other LCST containing water-soluble polymers that satisfy the structural requirements of the polymers in the rejected claims. The overall emulsifier polymer, as can be seen even in the abstract of Koerner, is water-soluble.

12. Regarding Fogel, as stated in col. 4, lines 46-50, the water-soluble polymers of Fogel have cloud points preferably less than 0 °C. Thus, they would be water-soluble in the range claimed by applicant.

13. Regarding both the Maroy publications, as with Merchant above, the prior art teachings are not limited to the species in the examples. The LCST groups, as identified in applicant's specification, are still generically taught by Maroy.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1713

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KCE

KELECHI C. EGWIM PH.D.  
PRIMARY EXAMINER

